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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/782,866	01/13/97	DELABASTITA	P GV-2166

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11M1/0902

EXAMINER  
ANGEBRANNDT, M

ART UNIT  
1113

22

DATE MAILED: 09/02/97

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

#### OFFICE ACTION SUMMARY

Responsive to communication(s) filed on 6/2/97 + 1/13/97

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-7 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-7 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) 0P/227075

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of Reference Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

- SEE OFFICE ACTION ON THE FOLLOWING PAGES -

Art Unit: 1113

15 the response provided by the applicant has been read and given careful consideration. Responses to the arguments raised by the applicants are provided after the rejection they are directed to. The specification should be amended to include references to the parent applications and their status which is --, now abandoned-- after the reference to the parent application.

16 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

17 Claims 1-6 are provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1-8 of copending application Serial No. 08/542094. This is a *provisional* double patenting rejection since the conflicting claims have not in fact been patented.

The only difference is in the substitution of "scan-wise exposing" in the instant claims in place of "image-wise exposing".

The applicant stated in the parent application that terminal disclaimer will be filed. A terminal disclaimer has not yet been filed in the instant application, therefore this rejection and the one in paragraph 19 below are maintained. Also a terminal disclaimer would not be sufficient to obviate a rejection under 35 U.S.C. § 101.

18 Claims 1-7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of copending application Serial No. 08/542094 in view of Saikawa et al. '811 or Peterson '762.

Art Unit: 1113

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Saikawa et al. '811 teaches the use of a laser or LED to expose a diffusion transfer which is developed using an alkaline processing solution. Examples of light sources are disclosed. col 1/lines 60-63, hereinafter 1/60-63, 2/32-42 and 2/55-65)

Peterson '762 establishes that it is known to use a laser to form a lithographic printing plate. The process uses a mixture of a diazo composition with nitrocellulose and carbon black. The carbon black absorbs light converting it heat and heating the nitrocellulose until it combusts, removing it from the support surface. The formation of letterpress printing plates is also disclosed.

It would have been obvious to use lasers or LEDs to expose the materials claimed in co-pending application 08/227073, based upon the teachings within the art to expose materials specifically forming lithographic printing plates, such as those provided by Saikawa et al. '811 or Peterson '762.

See the above paragraph for a response.

19 The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

Art Unit: 1113

20 The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

21 Claims 1,4,6 and 7 are rejected under 35 U.S.C. § 103 as being unpatentable over either

Saikawa et al. '811 or Monbaliu et al. '156, in view of Stoffel et al. (1981).

Monbaliu et al. '156 teaches the use of conventional sources, laser or LEDs for exposing silver diffusion media to form lithographic printing plates. (col 10/line 66-col 11/line 35, hereinafter 10/66-11/35). The processing is described in the abstract and claims as well as the text.

Stoffel et al. '(1981) teaches various techniques for use in scanning and screening images such as photographs and camera images to produce halftone images which are useful with binary output devices such as lithography. (Page 1898/col 1/paragraphs 1-2). Pages 1907,1908,1915,1916 and tables I & II describe the process of error diffusion and the benefits.

Art Unit: 1113

It would have been obvious to one skilled in the art to include frequency modulation screening techniques such as error diffusion taught by Stoffel et al. '(1981) in the techniques of producing printing plates disclosed by either Saikawa et al. '811 or Monbaliu et al. '156 with a reasonable expectation of gaining the benefits taught by Stoffel et al. '(1981), based upon the disclosure of Stoffel et al. '(1981) that this technique is applicable to lithography.

The applicant argues that apart from the fact that lithography covers the computer-to-plate techniques, the use of it with frequency modulation is new and inventive. The applicant admits that Stoffel et al. specifically states that the use of the algorithms described are compatible with lithography, although optimization is not specifically discussed with respect to each. The examiner holds this to support his position, not that of the applicant. Further the penultimate statement cited only points out to one of ordinary skill in the art that proper registration is necessary to avoid tone scale errors. The applicant does not exclude this registration process and it is generally recognized to be important in constructing multicolor images by those in the printing industry. Also the passage cited earlier by the applicant makes it clear that this is an overview and some optimization is required for each process it can be used with for it to reach its full potential. The examiner holds that this does not point away from the invention, but reminds one of ordinary skill in the art that these techniques are particularly registration sensitive. The examiner notes that passages cited by the applicant specifically point out the described techniques are general to the processes that they are taught as useful with and not directed to any particular process. The examiner maintains the rejection for the above reasons.

Art Unit: 1113

The applicant did not send the citations as indicated in the preamendment filed October 12, 1995. The applicant argues that neither of Saikawa et al. '811 or Monbaliu et al. '156 teach the use of screened data as the output of the laser exposure pattern and argues that both Saikawa et al. '811 and Monbaliu et al. '156 are non-analogous to Stoffel et al. '(1981). The examiner note these arguments and points out that the output of the lasers are controlled by digital data to produce the image and therefore must have some connection to a controlling means for performing the exposure in an imagewise manner. Neither Saikawa et al. '811 or Monbaliu et al. '156 teach using a physical masking element with the laser exposure process. Secondly, the first portion, ie the scanning of the image and screening of the data is fully disclosed by Stoffel et al. '(1981) as is its use in "lithography" set forth on page 1898 column 1, paragraph 2, line 3. The same terminology is used by both Saikawa et al. '811 and Monbaliu et al. '156 in their abstracts, therefore establishing a linkage between the arts and motivation to combine the teachings of Stoffel et al. '(1981) with those of the lithographic arts, including Saikawa et al. '811 and Monbaliu et al. '156. Additionally, the use of lithography as an binary output device is disclosed by Stoffel et al. Clearly, the laser exposure processes of both Saikawa et al. '811 and Monbaliu et al. '156 represent output devices. The examiner has relied upon the secondary reference to provide the motivation for the combination of these references. In Heidelberger Druckmaschinen A.G. v. Hantscho Commercial products the fields of endeavor are clearly different relating to printing presses, sheet metal working and compressors. No such divergence exists here all of the art is directed to producing images. Therefore, this citation is neither as relevant or persuasive as

Art Unit: 1113

the applicant would have it be. As set forth in the above citation on page 1377, "whether a reference is 'analogous art' is a question of fact". With respect to In re Geiger, the basis of obviousness of the combination of ingredients from three different references was at issue and from the passage in the second column of page 1278, it appears that no direction was provided to the other components. In the instant application ample direction is found within Stoffel et al., which directs on to the lithographic arts. While it does not specifically mention the complete recitation of the remaining portions of the claims, when doing so the examiner holds that one of ordinary skill in the art would be directed to lithographic printing plates and their manufacture based upon the teachings of the binary marking/display technologies section as well as the citation of "printing technologies-lithography, ..." within that section. As the only way in which lithographic printing may be performed is with a lithographic printing plate, the examiner holds that one of ordinary skill in the art would immediately recognize that this reference does direct one of ordinary skill in the art to the formation of lithographic printing plates as direct writing of the image onto the final page does not constitute lithography. The rejection is therefore maintained for these reasons.

The applicant argues that none of the references except Stoffel et al. '(1981) teach frequency modulation screening techniques and Monbaliu et al. '156 teaches autotypical screening and therefore teaches away from the claimed invention. The applicant argues that the examiner is merely picking and choosing references without a basis for combination. The examiner disagrees noting that the use of these screening techniques in lithography is taught in

Art Unit: 1113

Stoffel et al. (1981) and specific benefits are disclosed for error diffusion as disclosed on page 1909 over other screening and thresholding methods. The examiner holds that one would expect these benefits for any of the techniques which are disclosed as useful with these types of screening and holds that this provides sufficient motivation for its use in processes which use these techniques. Specifically, Stoffel et al. (1981) teaches the benefits over periodic screening techniques in high frequency rendition in particular. Stoffel et al. (1981) would be expected to make a showing of each of the techniques and compare them in one format, but comparisons for each and every technique would not be expected as nothing would be added by this and it would consist of mere repetition of the same benefits. Also note that gravure and lithography are both printing techniques and therefore the arguments on page 4, while more relevant than the others, is not found persuasive. Concerning the content of chapter VI, particular binary output means are not described here, but the effect of the various screening techniques is. The output means are noted in this chapter and the "input" is the sum of the information/picture/image and the screening technique used. This is not to be confused with the true input which would merely be the information/picture/image. The fact that error diffusion is a frequency modulation screening process does not prevent it from being used as to generate halftone images for printing images which closely resemble the continuous original, indeed that is exactly what the applicant uses it for. If the applicant has realized benefits other than those of the Stoffel et al. (1981) reference, then please come forward with them and these may provide a basis for patentability over the prior art. It is true that Stoffel et al. (1981) covers quite a bit of ground, but all of the techniques

Art Unit: 1113

produce halftone images as approximations of continuous tone images and lithography is among them. The output devices of the references other than Stoffel et al. (1981) are considered to be the print plates, the lasers are considered the devices used to produce these, are easily modulated in binary fashion and are used in this manner to produce the images on the printing plate substrates as the printing plates will only be binary (ink receptive/ink repellent). The examiner considers the broad disclosure of Stoffel et al. (1981) as evidence of the flexibility of the technique and based on this does not find reason not to connect this with lithography based upon the disclosure to use this and other screening techniques with lithography.

22      Claims 1,4,5 and 7 are rejected under 35 U.S.C. § 103 as being unpatentable over Peterson '762, in view of Stoffel et al. '(1981).

It would have been obvious to one skilled in the art to include frequency modulation screening techniques such as error diffusion taught by Stoffel et al. '(1981) in the techniques of producing printing plates disclosed by Peterson '762 with a reasonable expectation of gaining the benefits taught by Stoffel et al. '(1981), based upon the disclosure of Stoffel et al. '(1981) that this technique is applicable to lithographic, letterpress and gravure printing.

See the response provided in paragraph 21 above. The examiner also directs the applicant to the teachings of relief printing in the binary marking/display technologies section as well as the citation of "printing technologies-lithography, Letterpress and gravure ..." within the halftone imagery section.

Art Unit: 1113

23 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin Angebranndt whose telephone number is (703) 308-4397.

I am normally available between 7:30 AM and 5:00 PM, Monday through Thursday and 7:30 AM and 4:00 PM on alternate Fridays.

If repeated attempts to reach me are unsuccessful, my supervisor may be reached at (703) 308-2303.

Facsimile correspondence should be directed to (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

  
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Martin J. Angebranndt  
Primary Examiner, Group 1100  
September 1, 1997